



PATENT
Customer No. 22,852
Attorney Docket No. 09812.0153-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Teppei YOKOTA et al.)
) Group Art Unit: 2656
Application No.: 10/732,887)
) Examiner: HINDI, NABIL Z
Filed: December 9, 2003)
) Confirmation Number: 6181
For: APPARATUS AND METHOD)
FOR RECORDING DATA)
ONTO A PREDETERMINED)
RECORDING MEDIUM)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejections applied against this application for a reissued patent in the final Office Action mailed March 13, 2006. This Request is being filed with a Notice of Appeal. The period for response extends at least to June 13, 2006.

I. Compliance With Requirements For Submitting a Pre-Appeal Brief Request for Review

This submission complies with the requirements for requesting a pre-appeal brief review because: (1) the present application has been at least twice rejected; (2) this Request is being filed with a Notice of Appeal prior to the filing of an Appeal Brief; and

(3) this Request is five (5) or less pages in length and sets forth legal and/or factual deficiencies in the final rejections. See Official Gazette Notice, July 12, 2005.

II. Status of the Claims

Claims 1-39 are pending in this application. Claims 1, 10, 19, 28, and 34 are independent claims. In the final Office Action, claims 1-27 were allowed, claims 28-39 were finally rejected under 35 U.S.C. § 112, second paragraph for alleged indefiniteness, and claims 28-39 were finally rejected under 35 U.S.C. § 251.

III. Grounds for Traversing Final Rejection

Applicants filed this application requesting reissue of U.S. Patent No. 6,628,591 B1, issued on September 30, 2003, from U.S. Patent Application No. 09/690,543, filed October 17, 2000 ("the prior application"). Claims 1-27 are identical to claims 1-27 of U.S. Patent No. 6,628,591 B1. Claims 28-39 have been added in this reissue application.

On pages 2-3 of the final Office Action, the Examiner rejected claims 28-39 under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. Applicants respectfully request reversal of this rejection.

On page 3 of the final Office Action, the Examiner asserts:

claim 28 lacks continuity between the claimed limitations. The claim recites the use of a random-number generating unit. . . the determination result'. However the claim does not recite of what is being done with the random number after being generated.

35 U.S.C. § 112, second paragraph requires: "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." In interpreting 35 U.S.C. § 112, second

paragraph, the Federal Circuit held, in Energizer Holdings, Inc. v. Eveready Battery Company, Inc., 435 F.3d 1366, 1370 (Fed. Cir. 2006), “[t]he definiteness inquiry ‘focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification.’” (citing Union Pac. Res. Co. v. Chesapeake Energy Corp., 236 F.3d 684, 692 (Fed. Cir. 2001)). Accordingly, as the public is clearly informed of the scope of a claim including “a random-number generating circuit means for generating a random-number based on the determination result,” there is no indefiniteness.

Claim 34 recites “recording said reproduced information in a storage medium, said recording comprising encrypting and authenticating said reproduced information using a first security block, wherein said storage medium comprises a second security block.” The public is clearly informed that the claimed method includes “encrypting and authenticating said reproduced information using a first security block” and “recording said reproduced information in a storage medium. . . wherein said storage medium comprises a second security block.”

For at least the aforementioned reasons, Applicants respectfully request withdrawal of the Section 112, second paragraph rejections for alleged indefiniteness.

On pages 3-5 of the final Office Action, claims 28-39 were rejected under 35 U.S.C. § 251 for improper reissue recapture.

In the Amendment After Final filed October 12, 2005, Applicants amended independent claims 28 and 34 to each recite security blocks, encryption, authentication, and random-number generation. In response, the Examiner, on page 4 of the final Office Action, asserts:

Applicant did not amend the claims to include all of the limitations that was previously present in the original claims. Such limitation as cited above was part of the indicated allowable subject matter within the claims.

Independent claims 28 and 34 do not improperly recapture any subject matter surrendered during the prosecution of the prior application. The aspects set forth on page 4 of the final Office Action were not part of the indicated allowable subject matter within the claims of the prior application. Indeed, the Notice of Allowability in the prior application does not include any Statement of Reasons for Allowance.

In the prior application, Applicants amended claims 1, 10, and 19 to recite, "said recording means comprising a first security block having an encryption circuit and an authentication processing circuit, said first recording medium comprising a second security block," "random-number generation circuit means for generating a session key to be shared with said second security block if said judgement formed from said judging means indicates that said first recording medium is allowed to be dubbed," and "wherein said first security block sends first authentication data to said second security block which generates second authentication data and adds this second authentication data to the first authentication data and sends both authentication data to said recording means to form said judgement."

In the remarks with that Amendment, Applicants explained, "Ashe is not concerned with security blocks for encrypting and authenticating data, and does not teach a random-number generating circuit." This statement, directly preceding the notice of allowance, defines the proper limits of any alleged surrender. Consistent with Applicants' statement, claims 28 and 34, added in this reissue application, recite security blocks, encrypting and authenticating data, and a random-number generating

circuit. Because independent claims 28 and 34 recite the subject matter actually added to the claims to gain allowance, amended independent claims 28 and 34 are not a recapture. Ex Parte Eggert, 67 U.S.P.Q.2d 1716 (Bd. Pat. App. & Inter. 2003).

In addition, while independent claims 28 and 34 may be broader in certain aspects than claims 1-27 of U.S. Patent No. 6,628,591 B1, claims 28 and 34 include the subject matter of any alleged surrender in the prior application, and thus do not constitute recapture.

For at least the aforementioned reasons, Applicants respectfully request withdrawal of the Section 251 rejection.

IV. Conclusion

In light of the above arguments, and those presented on pages 2-5 of the Response filed February 8, 2006 and pages 7-8 of the Amendment After Final filed October 12, 2005, Applicants respectfully request allowance of pending claims 28-39.

Because the rejections include factual and/or legal deficiencies with regard to 35 U.S.C. §§ 112, second paragraph, and 251, Applicants are entitled to a pre-appeal brief review of the final Office Action, and request that the claim rejections be withdrawn and the claims allowed.

Respectfully submitted,

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Dated: May 15, 2006